



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

100

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/135,238 08/17/98 NOLAN

G A-65635-1/DJ

EXAMINER
----------

SHUKLA, R

ART UNIT	PAPER NUMBER
----------	--------------

1632

DATE MAILED:

08/23/99

FLEHR HOHBACH TEST  
ALBRITTON & HERBERT  
4 EMBARCADERO CENTER SUITE 3400  
SAN FRANCISCO CA 94111

HM12/0823

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/135,238

Applicant(s)

Nolan et al

Examiner

Ram Shukla

Group Art Unit

1632



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-33 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-33 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1632

#### DETAILED ACTION

1. Claims 1-34 are pending in the instant application.

#### *Election/Restriction*

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-17, 30 and 32, drawn to nucleic acids and gene therapy, classified in class 514, subclass 44.
  - II. Claims 18-21 and 33, drawn to proteins and protein therapy, classified in class 514, subclass 2.
  - III. Claim 22, drawn to a protein, classified in class 530, subclass 350.2.
  - IV. Claims 22-29 and 34, drawn to antibodies and antibody therapy, classified in class 435, subclass 7.1.
  - V. Claim 31, drawn to a mammalian cell, classified in class 435, subclass 325.
3. Claim 22 is generic to groups III and IV. Should any of these groups be elected, claim 22 will be examined to the extent it encompasses the elected invention.
4. The inventions are distinct, each from the other because of the following reasons: The inventions of the groups I, II, III, IV, and V are patentably distinct each from the other because they are drawn to materially different compositions that have different chemical structure and physical properties and utilities. For example, the invention of group I is drawn to nucleic acids and their use in gene therapy, which is different from the invention of group II, a protein and use of protein in therapy because proteins and nucleic acids have different chemical and physical characteristics and their functions and utilities are distinct. Likewise antibodies have different characteristics and utilities compared to proteins and nucleic acids. The inventions of groups II and III, both, are drawn to proteins but they are distinct each from the other because they are drawn to two different proteins, the invention of group II is drawn to a TOSO protein whereas the invention of group III is drawn to a TOSO binding protein. The TOSO protein may have completely different properties compared to the protein that bind to TOSO based on the domain of TOSO involved in protein binding. Furthermore, there can be multiple proteins that may have different characteristics and still can bind to TOSO protein. The invention of group V is drawn to a recombinant mammalian cell that expresses a modified TOSO receptor and is patentably

Art Unit: 1632

distinct from the inventions of the groups I-IV because a cell is composed of proteins, nucleic acids, lipids and other components and its function or phenotype may depend on the nucleic acid or genes it is expressing or on the tissue of its origin. Therefore, the inventions of groups I-V are patentably distinct each from the other and their analysis will require separate searches, for example, in the non-patent literature.

5. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art shown by their different classification and their recognized divergent subject matter, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

6. A telephone call was made to Ms. Robin Silva on 7-27-99 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Stanton, can be reached on (703) 308-2801. The fax phone number for this Group is (703) 308-8724.

Application/Control Number: 09/135,238

Page 4

Art Unit: 1632

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-0196.

Ram R. Shukla, Ph.D.

A handwritten signature in black ink, reading "Bruce Campell". The signature is written in a cursive style with a large, stylized "B" and "C".

BRUCE R. CAMPPELL  
PRIMARY EXAMINER  
GROUP 1800